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EXAMINER	
HUANG, CHENG YUAN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ATTACHMENT TO ADVISORY ACTION

Response to Arguments

1. Applicant's arguments filed 28 September 2010 have been fully considered but they were not persuasive.

2. Applicants amended claims 1 and 3 to include the limitation of cancelled claim 11 and claim 9 to include "provided on a specular reflective layer".

3. Applicants argue that "Yamamoto's optical article is sunglasses and ski goggles, none of which feature destructive sheets that peel off" and "it is not at all obvious for a skilled person to apply Yamamoto's invention relating to optical articles that are used without peel-off optical sheets to Hingsen's invention in which optical sheets break when they are peeled off".

4. However, note that while Yamamoto et al. does not disclose all the features of the present claimed invention, Yamamoto et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely an optical article comprising alicyclic polyolefin or alicyclic acrylic resin, and in combination with the primary reference, discloses the presently claimed invention.

5. Further, the recitation in the claims that the destructive layer is "applied to a substrate and is removed..." is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such

structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

6. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Hingsen-Gehrmann et al. as modified by Yamamoto et al. disclose retroreflective sheeting as presently claimed, it is clear that the destructive layer of Hingsen-Gehrmann et al. as modified by Yamamoto et al. would be capable of performing the intended use, i.e. be applied to a substrate and removed, etc., presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

7. In other words, the functional limitation "wherein, when the retroreflective sheeting has been applied to a substrate and is removed, peeling takes place at the interface of the destructive layer and the layer which is in intimate contact therewith and/or by destruction of the destructive layer" is considered to define the particular capability of the retroreflective sheeting to be applied to a substrate and the destructive layer to peeling and/or destruct. Since the structure and materials of the retroreflective sheeting of Hingsen-Gehrmann et al. as modified by Yamamoto et al. are identical to those of the presently claimed invention, when the invention is applied to substrate and removed, the peeling would intrinsically take place at the interface of the destructive layer and the layer which is in intimate contact therewith and/or by destruction of the destructive layer as presently claimed. Furthermore, Hingsen-Gehrmann et al. teaches the application of the retroreflective sheeting to a substrate (substrate 90, paragraph [0072], Fig 2 & Fig. 4) and the subsequent peeling and destruction of the destructive layer (paragraph [0072]).

8. Lastly, there is proper motivation to combine Hingsen-Gehrmann et al. with Yamamoto et al. given that Hingsen-Gehrmann et al. teaches said destructive layer being polyester or polyacrylate resins (paragraph [0059]) but fails to teach the destructive layer being an alicyclic polyolefin resin or alicyclic acrylic resin and that Yamamoto discloses teaches an optical article (See title) comprising a principal chain hydrocarbon having an adamantine ring or a cyclopentane ring (paragraph [0043]) which are alicyclic polyolefin resins and the use of polyester or acrylics (paragraph [0043]), which, in doing so, teaches the functional equivalence between hydrocarbon resins based on cyclical residues and polyester and acrylic resins.

9. Since both Hingsen-Gehrmann et al. and Yamamoto et al. teach inventions drawn to optical articles, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the hydrocarbon resin-based cyclical residues of Yamamoto et al. in the destructive layer of Hingsen-Gehrmann et al. as a known functional equivalent of polyester and acrylic resins since Yamamoto et al. teaches that various polymers, including polyesters and acrylic resins may be used, along with alicyclic polyolefin resins. Substitution of known components with other components that yield predictable results would have been obvious to one of ordinary skill in the art since predictable characteristics such as optical clarity, toughness, and heat resistance (paragraph [0044]) would have been affected by using alicyclic polyolefin resins or polyester or acrylic resins in the destructive layer of optical articles. See MPEP 2144.06 II.

10. Applicants argue that the prior art does not teach the specific peeling strength as now required in amended claims 1 and 3.

11. However, as disclosed in the previous Office Action, given that Hingsen-Gehrmann et al. as modified by Yamamoto et al. teaches identical materials of alicyclic polyolefin resins or

cyclopentane resin wherein R^1 is hydrogen for the destructive layer of the retroreflective sheeting, as disclosed in claims 1 and 4, it is expected that the destructive layer intrinsically possesses the claimed peeling strength.

12. Applicants argue that the double patenting rejection is overcome in light of the amendment.

13. In light of the amendment, the double patenting rejection of record as set forth in paragraphs 34 to 39 of the office action mailed 03 March 2010 is overcome.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1787

October 5, 2010

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787